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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/779,869

02/08/2001

Steven M. Horowitz

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6689

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7590

12/14/2006

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EXAMINER

LAMBRECHT, CHRISTOPHER M

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,869

Applicant(s)

HOROWITZ ET AL.

Examiner

Christopher M. Lambrecht

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,12,14,15,17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,12,14,15,17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 12, 14, 15, 17, and 19-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 12, 14, 15, 17, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sie et al. (Sie), U.S. Patent No. 7,024,679.

Regarding claim 1, Sie discloses a set-top box (600, col. 7, lines 35-39) including a receiver (500) that receives digital programming content (col. 5, lines 65-67) comprising multiple channels (col. 6, lines 12-14). The programming content of each channel is provided to the set top box in an encoded digital format (col. 6, lines 18-21), which is determined by the provider of the content (i.e., received from the provider in such format). Sie further discloses a method for recording one or more selected channels (in program server 132) without decoding them prior to recording (program server 132

precedes display interface 524 (where decoding is performed, col. 6, lines 34-37) in the signal path; see fig. 6). The recorded channels are therefore stored in the same encoded digital format as determined by the content provider and the quality of recording is not degraded. Further, the method enables display of one of the recorded channels while recording another one of the selected channels (col. 14, lines 33-37).

At the set top box, a first channel is isolated and selected from a multiplexed signal containing multiple channels of digital programming content using a single tuner (508) and a demodulator (512), producing a multiplexed transport stream comprising audio, video, and data packets (MPEG signal, col. 6, lines 17-21; col. 16, lines 9-11) associated with the first channel. Next, a transport demultiplexer (516) demultiplexes the transport stream to isolate the selected first channel (col. 6, lines 24-31). The contents of the first channel are then sent to a storage medium (132) in the set-top box and stored prior to decoding (col. 7, lines 46).

The method further includes retrieving, decoding, and displaying (in an analog format, e.g., NTSC; col. 6, lines 34-39; col. 13, lines 36-42), on a display device (television), the previously stored digital content of a second channel from the storage medium while storing the content of the first channel (col. 14, lines 20-37).

As to claim 12, Sie discloses that the first channel is compressed (col. 6, lines 30-31).

As to claim 14, Sie discloses the decoder produces an NTSC format output (col. 6, lines 34-37); NTSC signals include both audio and video components.

As to claim 15, Sie discloses that displaying the content of the second channel is performed while storing the contents of the first channel (col. 14, lines 33-37).

Regarding claim 17, Sie discloses the claimed apparatus as discussed above with respect to claim 1.

As to claim 19, Sie discloses that the decoder (524) is adapted to display the second channel on the display device while the first channel is recorded on the storage device (col. 13, lines 39-42, col. 14, lines 33-37).

As to claim 20, Sie further discloses the decoder (524) is also coupled to the transport demultiplexer (516) so that a selected first channel output from the demultiplexer may be simultaneously directed to both the storage device and the decoder (see figure 6).

As to claim 21, Sie discloses an apparatus as defined in claim 17, further comprising a conditional access system (controller 612) for determining whether a selected channel may be displayed (col. 7, lines 48-52, col. 8, line 64 - col. 9, line 3).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,996,101 (figure 8); U.S. Patent Application Publication No. 2004/0181814 (figure 5).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2623

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____
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Signature: _____

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Lambrecht whose telephone number is (571) 272-7297. The examiner can normally be reached on Mon-Fri, 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M. Lambrecht
Examiner
Art Unit 2623

cml



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